

REMARKS

Claims 1-22 are pending in this application. Claims 1-13 are rejected under 35 U.S.C. § 103 as obvious while claims 14-22 are newly added by this amendment. Claims 3-5 have been amended to conform with the specification in accordance with the Examiner's suggestion.

Applicants respectfully traverse the rejection of claims 1-13 under 35 U.S.C. § 103 as obvious over Trebes (U.S. Patent No. 6,317,438) in view of Behfar (WO 00/77620) and in further view of Edens (U.S. Patent No. 6,611,537). Reconsideration is respectfully requested.

Applicants assert that the Office action fails to make a prima facie case of obviousness because the Office action fails to identify a proper motivation or suggestion to combine the teachings of the cited references. Applicants note that the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. MPEP § 2142. Furthermore, as the Federal Circuit explained, "[i]n the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *Id.*

As further explained by the Federal Circuit in *In re Rouffet*:

“virtually all [inventions] are combinations of old elements.” Therefore, an Office action may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Office action to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Office action to show a motivation to combine the references that create[s] the case of obviousness. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Therefore, in order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

While Behfar discloses a vehicle with an Ethernet network, Behfar does not disclose an active network and therefore, the Office action relies on Trebes for such a teaching. In its analysis of the Trebes invention the Office action asserts that active networks are known for performing customized computations, performing self-healing, and controlling traffic flow. The Office action then concludes that an active network would be obvious for integrating components (“it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the concept of 'active networks' within Behfar so as to allow integrating components to perform customized configurations and controlling traffic flow.”) However, this argument is non sequitur because the Office action fails to explain how customized computations, self healing, and controlling traffic flow relates to using an active

network to integrate components in a vehicle system. The Examiner has the burden of demonstrating this connection, and without anything further, the Office action fails to show how Trebes and Behfar teach a motivation or suggestion to use an active network in a vehicle for integrating vehicle systems. *See* MPEP § 2142; *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986) ("When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper."); *See also Ecolchem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'"))

Next, the Office action acknowledges that neither Behfar nor Trebes teaches a communication path comprising a loop, and instead relies on Edens for such a teaching. However, instead of identifying a motivation in the prior art for combining the art, the Office action recites the characteristics of a loop network (i.e., "a loop topology network provides for 'same' information propagation to all device connected within the loop"), and then concludes that using the loop of Edens in Behfar and Trebes is obvious because characteristics of the loop network are contained in the recited combination ("using the loop topology scheme within Behfar and Trebes would help to disseminate the 'same' information to all devices....") This, however, is not a proper motivation or suggestion to combine because the Office action merely recites a characteristic of an element of a combination and then reasons that the combination comprising the element is obvious because the combination has the same inherent characteristic of the individual element. This is not a motivation to combine, but rather, a restatement of the combination in terms of its individual parts.

Applicants contend that without anything further, the Office action appears to rely solely on hindsight analysis, *i.e.*, taking the disclosure of the pending application as a blueprint for piecing together the prior art. *See Ecolochem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 1372 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) ("Combining prior art references without evidence of [] a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.' ") As stated in *In re Rouffet* above, this approach has long been rejected by the Federal Courts, and therefore the rejection of pending claims 1-13 as obvious over Behfar, Trebes and Edens is improper.

Applicants further assert that not only is no motivation or suggestion to combine identified by the Office action, no motivation or suggestion can be found in Behfar, Trebes, and Edens. As acknowledged in the pending application, Behfar is primarily concerned with interconnecting info-tech display devices which do not require time-critical communication. Therefore, in Behfar, a simple network, such as an Ethernet network, would be sufficient to address the concerns disclosed in Behfar. Behfar does not recognize the problem of integrating various vehicle control systems having time-critical applications that require, among other things, communication prioritization or packet translation, and therefore, Behfar cannot possibly suggest any motivation to use any specialized network architecture, such as an active network, for interconnecting its devices.

Furthermore, neither Trebes nor Edens recognizes a vehicle system integration problem because Trebes is primarily concerned with a network process for communicating data between two service providers on a telecommunication network, while Edens is primarily concerned with enabling home entertainment devices to interoperate using a ring

network. Neither of these references recognize the problem of enabling communication between disparate vehicle systems.

In order to more fully claim the disclosed invention, Applicants have added claims 14-22. Each of claims 14-22 recite an vehicle active network comprising network elements coupled by communication links using different network protocols. Because none of Behfar, Trebes, and Edens recites an active network comprising communication links using different network protocols, claims 14-22 cannot be anticipated by Behfar, Trebes, or Edens and cannot be rendered obvious over any combination of Behfar, Trebes, and Edens.

CONCLUSION

Applicants submit that this case is in a condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request allowance of claims 1-22.


The Examiner is hereby authorized to charge any fees which may be required for consideration of the claims to Deposit Account No. No. 13-2855 of Marshall, Gerstein & Borun LLP.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call its attorney at the number listed below.

Respectfully submitted,

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